

REMARKS/ARGUMENTS

The present application is a continuation of U.S. Patent Application No. 09/912,067 (the '067 application). In amendments filed for the '067 application on May 17, 2002 and January 17, 2003, Applicants noted that some of the then-pending claims were copied from the claims of U.S. Patent Application No. 08/770,123 (the '123 application), filed December 18, 1996, in the name of Callister et al. and entitled "Contraceptive System and Method of Use," which was published as U.S. Patent Application Publication No. US 2002/0013589 on January 31, 2002. In particular, claims 12-14 filed for the '067 application on May 17, 2002 corresponded exactly to and were copied from claims 49, 52, and 53 of the '123 application as those claims were pending on January 10, 2002. Claim 15 filed for the '067 application on May 17, 2002 substantially corresponded to claim 53 of the '123 application as that claim was pending on January 10, 2002. Claims 16 and 17 filed for the '067 application on January 17, 2003 corresponded exactly to and were copied from claims 49 and 53 of the '123 application as those claims were pending on August 21, 2002. Claims 18-24 filed for the '067 application on January 17, 2003 substantially corresponded to claims 54-60 of the '123 application as those claims were pending on August 21, 2002. Claims 22-34 of the present application are identical to claims 12-24 of the '067 application, as those claims were pending for that case on January 17, 2003.

The present preliminary amendment adds new claims 38-81 based on currently pending claims of the '123 application. In particular, claims 38, 39, 40, 42, 45, 47-55, 58-69, and 71-79 added in this preliminary amendment correspond exactly to and were copied from claims 49, 52, 53, 55, 58, 60, 62-69, 72-74, 76, 78-85, 88, 89, 91, 92, 94, and 96-99, respectively of the '123 application as those claims were pending on March 11, 2003 (the most recently filed response in the '123 application per the publicly available information of the USPTO's Patent Application Information Retrieval "PAIR" system). Claims 41, 43, 44, 46, 56, 57, 70, 80 and 81 added in the present preliminary amendment correspond substantially with claims 54, 56, 57, 59, 70, 71, 86, 100, and 53 respectively of the '123 application as those claims were pending on March 11, 2003. Additionally, claims 28-32 of the present application have been amended in this preliminary amendment to correct inadvertent typographical errors.

Applicants respectfully request that an Interference be declared under 37 C.F.R. §1.604 between the present application and the '123 application, filed December 18, 1996, in the name of Callister et al. and entitled "Contraceptive System and Method of Use," which was published as U.S. Patent Application Publication No. US 2002/0013589 on January 31, 2002.

The effective filing date of the present application is earlier than that of the '123 application, so that Applicants will be senior party in the requested interference. The present application is a continuation of U.S. Patent Application No. 09/912,067 (filed on July 23, 2001, now U.S. Patent No. 6,684,884), which was a continuation of U.S. Patent Application No. 09/592,123 (filed on June 12, 2000, now U.S. Patent No. 6,526,979), which was a continuation of U.S. Patent Application No. 09/324,078 (filed on June 1, 1999, now U.S. Patent No. 6,634,361), which was a continuation-in-part of U.S. Patent Application No. 09/093,835 (filed on June 8, 1998), which claimed the benefit of priority from U.S. Provisional Patent Application No. 60/059,861 (filed on September 24, 1997) and was also a continuation-in-part of U.S. Patent Application No. 08/475,252 (filed on June 7, 1995). Original parent application 08/475,252 further incorporated by reference the full disclosure of U.S. Patent Application No. 08/474,779, which was filed on the same day as the original parent application, June 7, 1995, and is now U.S. Patent No. 6,176,240. See original parent application 08/475,252, page 3, lines 24-27 and page 10, lines 27-33. Copies of each of the above-mentioned applications, as filed, are attached for the Examiner's convenience. Support for the Proposed Count is found in Applicants' originally filed parent application 08/475,252 of June 7, 1995 (as well as the subject application and the intervening parent applications). In contrast, the '123 application was filed on December 18, 1996 and does not claim priority to an earlier date. Based on these relative dates, Applicants' effective filing date of June 7, 1995 is well before the '123 application's effective filing date of December 18, 1996. Accordingly, Applicants should be designated as the senior party for the requested interference.

Showing in Support of Requested Interference

Under 37 C.F.R. §1.604 and M.P.E.P. §2304, Applicants request this interference be declared between the present application and the '123 application. Applicants have satisfied each requirement of §1.604, which is reproduced in its entirety for the Examiner's convenience:

Sec. 1.604 Request for interference between applications by an applicant.

- (a) An applicant may seek to have an interference declared with an application of another by, (1) Suggesting a Proposed Count and presenting at least one claim corresponding to the Proposed Count or identifying at least one claim in its application that corresponds to the Proposed Count, (2) Identifying the other application and, if known, a claim in the other application which corresponds to the Proposed Count, and (3) Explaining why an interference should be declared.*
- (b) When an applicant presents a claim known to the applicant to define the same patentable invention claimed in a pending application of another, the applicant shall identify that pending application, unless the claim is presented in response to a suggestion by the examiner. The examiner shall notify the Commissioner of any instance where it appears an applicant may have failed to comply with the provisions of this paragraph.*

- (1.) Per Rule 1.604(a), Applicants are seeking to have an interference declared with the '123 application, which is assigned to Ovion, Inc. As the present application is assigned to Conceptus, Inc., the '123 application is the application "of another" under Rule 1.604(a).
- (2.) Per 1.604(a)(1), the Proposed Count is as follows:

The Count

- i) A contraceptive device, comprising

- a) a tubular body which has a longitudinal axis, which is at least in part configured to be radially expanded about the longitudinal axis within a lumen of a patient's reproductive system from a first tubular configuration to a second retained tubular configuration having larger transverse dimensions than the first tubular configuration to facilitate securing a least a portion of the tubular body to a wall portion defining at least in part a lumen of a patient's reproductive system and which has an open structure in the retained expanded configuration facilitating the ingrowth of tissue cells; and
- b) a member at least partially within the expandable tubular body which is configured for tissue growth;

or

- ii) A contraceptive device, comprising
 - a) a body expandable within a lumen of a patient's reproductive system from a first tubular configuration to a second tubular configuration, the second tubular configuration having a larger cross-sectional profile than the first tubular configuration relative to an axis of the contraceptive device to facilitate securing at least a portion of the body to a wall portion defining at least in part a lumen of a patient's reproductive system, the body comprising a helical coil and allowing the ingrowth of tissue;
 - b) a material disposed at least in part within the expandable body so as to incite tissue in-growth.

The Proposed Count is a phantom count having a first part (i) corresponding exactly to claim 53 of the '123 application, as that claim was pending in an amendment filed for the '123 application on March 11, 2003. A second part (ii) of the Proposed Count corresponds exactly to claim 81 of the present application, a claim substantially corresponding to claim 53 of the '123 application as that claim was pending on March 11, 2003.

Applicants have presented in the present preliminary amendment claims 22-34 and 38-81, all of which correspond to the Proposed Count. Claim 40 of the present application corresponds exactly with the first part (i) of the Proposed Count. Claim 81 of the present application corresponds exactly with the second part (ii) of the Proposed Count. Claims 22-34, 38, 39, and 41-80 of the present application substantially correspond to the Proposed Count.

- (3.) Per Rule 1.604(a)(2), the other application is U.S. Patent Application No. 08/770,123, filed December 18, 1996, in the name of Callister et al. and entitled "Contraceptive System and Method of Use," which was published as U.S. Patent Application Publication No. US 2002/0013589 on January 31, 2002 (the '123 application). All claims (1-9 and 11-100) of the '123 application, as currently pending on March 11, 2003, correspond to the Proposed Count. Claim 53 of the '123 application corresponds exactly with the first part (i) of the Proposed Count. Claims 1-9, 11-52, and 54-100 substantially correspond with the Proposed Count, since each would have been obvious in view of the Proposed Count. Moreover, there is no indication that any of the claims in the '123 application define a separately patentable invention. Per 37 C.F.R. §1.603 "[a]ll claims in the applications which define the same patentable invention as a count shall be designated to correspond to the count."
- (4.) Per Rule 1.604(a)(3), an interference should be declared to prevent two patents from issuing with claims directed to the same patentable invention. Through publication of the pending '123 application, Applicants have learned that the claims of the '123 application are directed to Applicants' invention. As Applicants originally filed our application for this invention on June 7, 1995, and as the '123 application was not filed until December 18, 1996, Applicants also seek to prevent the U.S. Patent Office from issuing a patent under an application which was not filed until a year and a half after we first filed for patent protection of this subject matter.

- (5.) Per Rule 1.604(b), claims 22-24 of the present application correspond exactly to and were copied from claims 49, 52, and 53 of the '123 application as those claims were pending on January 10, 2002. Claim 25 of the present application substantially corresponds to claim 53 of the '123 application as that claim was pending on January 10, 2002. Claims 26 and 27 of the present application correspond exactly to and were copied from claims 49 and 53 of the '123 application as those claims were pending on August 21, 2002. Claims 28-34 of the present invention substantially correspond to claims 54-60 of the '123 application as those claims were pending on August 21, 2002. Claims 38, 39, 40, 42, 45, 47-55, 58-69, and 71-79 added in this preliminary amendment correspond exactly to and were copied from claims 49, 52, 53, 55, 58, 60, 62-69, 72-74, 76, 78-85, 88, 89, 91, 92, 94, and 96-99, respectively of the '123 application as those claims were pending on March 11, 2003. Claims 41, 43, 44, 46, 56, 57, 70, 80 and 81 added in the present preliminary amendment correspond substantially with claims 54, 56, 57, 59, 70, 71, 86, 100, and 53 respectively of the '123 application as those claims were pending on March 11, 2003.

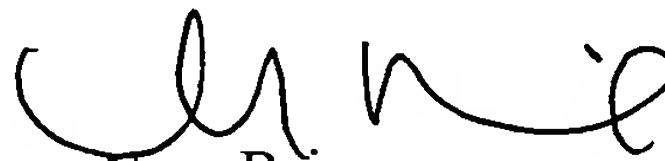
As a final matter, Applicants note that §2304 of the M.P.E.P. states that: “If the applicant presents a new claim to provide an interference with a published application, the examiner should determine whether the new claim is barred under 35 U.S.C. §135(b)(2).” 35 U.S.C. 135(b)(2), in turn, states that: “A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an application published under section 122(b) of this title may be made in an application filed after the application is published only if the claim is made before 1 year after the date on which the application is published.” As the '123 application was published on January 31, 2002, and as the '067 parent application amendments were filed on May 17, 2002 and January 17, 2003 (i.e., prior to January 31, 2003) as noted above on page 16, claims 22-34 and 38-81 of the present application have been filed within the one-year deadline of M.P.E.P. §2304 and 35 U.S.C. §135(b)(2).

CONCLUSION

In view of the foregoing, Applicants respectfully request that the Examiner declare an Interference with the '123 application.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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